

REMARKS

Claims 1-5 remain pending in this patent application. No amendments to the claims are made in this paper.

FOREIGN PRIORITY

On January 15, 2004, the filing date of this application, Applicant claimed a right of priority under 35 USC § 119 and 37 CFR § 1.55(a) and submitted a certified copy of the priority document. Applicant respectfully requests that the Examiner acknowledge the claim for priority and receipt of the priority document in the next communication from the USPTO.

PRIOR ART REJECTION I

Claim 1 was rejected under 35 USC § 102(b) as being anticipated by US 5611723 (Mitoma et al.). Applicant respectfully traverses this rejection.

The golf ball manufacturing method recited in claim 1 includes a combination of steps including an attitude regulating step and a seam processing step. In the attitude regulating step, a golf ball is oriented so that the seam of golf ball with a spew on the seam is placed in a predetermined position. In the seam processing step, while the golf ball is rotated in the circumferential direction of the seam, the spew or seam is subjected to cutting or grinding by means of a rotary processing tool having a processing direction to be inclined to the seam. As explained in the specification of this application, golf balls made using the steps recited in claim 1 exhibit superior properties compared to golf balls made according to known prior art methods.

The Mitoma et al. machine for removing burrs from a golf ball includes an attitude modifying apparatus 100 and a grinding apparatus 200. At stations ST0 through ST5 of the attitude modifying apparatus 100, a golf ball is oriented so that burrs formed on the equator of the ball are positioned in a horizontal plane. At station ST9 of the grinding apparatus, a golf ball with burrs oriented in a horizontal plane is rotated about a vertical axis and is brought into contact with rotary cutter 47, which removes the burrs. See column 10, lines 12-22. The only disclosure in Mitoma et al. relating to the attitude of the cutter is provided by Fig. 1, which shows the cutter mounted for rotation about an axis that is parallel to the (vertical) rotational axis

of the golf ball. From the foregoing observations, it is apparent that Mitoma et al. discloses a golf ball de-burring machine that can be fairly characterized as performing the attitude regulating step recited in Applicant's claim 1. It is also apparent that, in the Mitoma et al. grinding apparatus 200, the cutting or grinding performed by cutter 47 occurs in a plane that is coincident with or parallel to the plane in which the burrs on the golf ball are positioned. There is no disclosure or suggestion in Mitoma et al. of a cutting or grinding operation performed by a "rotary processing tool having a processing direction to be inclined to the seam while rotating the golf ball in a circumferential direction of the seam," as clearly recited in claim 1.

In view of the foregoing observations, Applicant submits that the disclosure in Mitoma et al. cannot properly serve as a basis for rejecting claim 1 under 35 USC § 102(b).

PRIOR ART REJECTION II

Claim 2 was rejected under 35 USC § 103(a) as being unpatentable over Mitoma et al. Applicant respectfully traverses this rejection.

The Examiner concedes that Mitoma et al. does not "teach the claimed angle formed by the processing direction and the seam" but maintains that, "The angle formed by a processing direction and a seam is well known in the deburring art," that "the claimed angle would have been readily determined by routine experimentation by one of ordinary skill in the art" and that "the claimed angle is well known in the deburring art."

As noted above, there is no disclosure or suggestion whatsoever in Mitoma et al. of any inclination of a processing direction of cutter 47 relative to the orientation of burrs to be removed by the cutter. Applicant therefore submits that the "well known" angles asserted by the Examiner are speculative and are not supported by any evidence identified by the Examiner. Applicant is challenging the Examiner's "well known" assertion as not properly officially noticed or not properly based upon common knowledge. Accordingly, under the guidelines stated in MPEP 2144.03 C, Applicant submits that the Examiner is now obligated to identify evidence that supports the "well known" finding.

In view of the foregoing observations, Applicant submits that Mitoma et al. cannot properly serve as a basis for rejecting claim 2 under 35 USC § 103(a).

PRIOR ART REJECTION III

Claims 3-5 were rejected under 35 USC § 103(a) as being unpatentable over Mitoma et al. in view of US 3073072 (Selby). Applicant respectfully traverses this rejection.

In the statement of this rejection, the Examiner characterizes Mitoma et al. as teaching "the basic claimed process" including "a first processing step of cutting or grinding the spew or the seam by means of a rotary processing tool having a processing direction to be inclined to the seam while rotating the golf ball in a circumferential direction of the seam." As Applicant makes clear above, Mitoma et al. does not disclose such a processing step.

The Examiner acknowledges that the disclosure in Mitoma et al. cannot meet the requirement in Applicant's claims 3-5 for a second processing step performed "by means of a rotary processing tool having a processing direction to be inclined to the seam and to cross the processing direction at the first processing step with the seam interposed therebetween while rotating the golf ball in the circumferential direction of the seam." As a remedy for this deficiency of the Mitoma et al. disclosure vis-à-vis the requirements of Applicant's claims, proposes modifying the Mitoma et al. grinding process so that it performs grinding in crossing directions, as taught by Selby. Again, the Examiner asserts that the claimed angles are "well known in the deburring art."

In the Selby apparatus, a grinding wheel 2 performs surface grinding on a workpiece supported on work table *d*, which is movable under the grinding wheel in two mutually orthogonal directions that are parallel to the rotational axis of the grinding wheel. There is no disclosure or suggestion of performing grinding on a spherical work piece, such as a golf ball, much less a spherical work piece that rotates as it is ground. From the foregoing observations, it is apparent that the teachings in Selby would not have been obviously applicable to the deburring operation performed by the Mitoma et al. apparatus, as proposed by the Examiner, and that any combination of teachings in Mitoma et al. and Selby could not yield an apparatus that could perform the steps required by Applicant's claims 3-5.

Again, Applicant challenges the Examiner's assertions of "well known" angles.

In view of the foregoing observations, Applicant submits that no reasonable combination of the disclosures in Mitoma et al. and Selby can properly serve as a basis for rejecting any of claims 3-5 under 35 USC § 103(a).

CONCLUSION

In view of the observations and arguments presented herein, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections stated in the outstanding Office Action and recognize all of the pending claims as allowable.

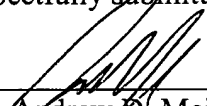
If unresolved matters remain in the present application, Applicant invites the Examiner to contact Frederick R. Handren, Reg. No. 32,874, at the telephone number of the undersigned below, to conduct an interview with the objective of expediting the prosecution of this application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: October 10, 2006

Respectfully submitted,

By


Andrew D. Meikle

Registration No.: 32,868

BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant